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First Named Inventor	Michael Wayne Brown
Art Unit	2645
Examiner Name	Elahee, MD S
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AUS920010819US1
APPEAL BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael Wayne Brown, *et al.* § Group Art Unit: 2645
§
Serial No.: 10/015,281 § Examiner: Elahee, MD S.
§
Filed: December 12, 2001 § Atty Docket No.: AUS920010819US1
§
Title: Intermediary Device Initiated
Caller Identification §
§
§

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Catherine Berglund

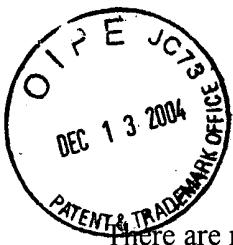
APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of August 12, 2004, and pursuant to the Notice of Appeal filed October 7, 2004.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation (“IBM”), a New York corporation having a place of business at Armonk, New York 10504.



RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-21, 52, and 53 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR§ 41.37(c)(1)(vii), including references to the specification by page and line number and to the drawing(s) if any, by reference characters.

Methods, systems, and products are provided for externally identifying a particular caller that described for example at page 12, line 24 – page 18, line 5 with reference to Figure 1; page 32, line 25 – page 39, line 15 with reference to Figure 4; and page 37, line 17 – page 39, line 15 with reference to Figure 5. Embodiments include receiving a voice utterance for a caller at a server external to a trusted telephone network (S24 of Figure 5) and identifying a caller identity associated with the voice utterance at the server (S25 of Figure 5), such that the caller identity is transmittable within the trusted telephone network as an authenticated identity of a caller for a call (S26 of Figure 5).

Methods, systems, and products for specifying telephone services for a particular caller are also described for example at page 12, line 24 – page 18, line 5 with reference to Figure 1; page 32, line 25 – page 39, line 15 with reference to Figure 4; and page 37, line

17 – page 39, line 15 with reference to Figure 5. Embodiments include detecting a call initiation condition from an origin device at a trusted telephone network (S1 and S2 of Figure 5); brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service (S20, S21 and S22 of Figure 5); and responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing the origin device, specifying services available to the caller according to said authenticated caller identity (S9 and S10 of Figure 4).

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

GROUNDS OF REJECTION

Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52 and 53 stand rejected under 35 U.S.C § 102(e) as being anticipated by McAllister, *et al.* (U.S. Patent No. 6,442,242). Claims 4, 13, and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister (U.S. Patent No. 6,442,242) in view of Bartholomew, *et al.* (U.S. Patent No. 6,167,119). Claims 8 and 17 stand rejected as unpatentable over McAllister (U.S. Patent No. 6,442,242) in view of Yoon, *et al.* (U.S. Pub. No. 2001/0047414)

The final office action of August 12, 2004, characterized Applicants' description of McAllister as brief, conclusory, and general. The office action also stated that Applicants' arguments did not specifically distinguish McAllister as required by 37 CFR 1.111(b). Applicants are in compliance with 37 CFR 1.111(b) because Applicants did in fact specifically distinguish McAllister. Applicants described McAllister and Applicants specifically demonstrated that McAllister does not disclose trusted and untrusted telephone networks or externally identifying a particular caller. The fact that Applicants did specifically distinguish McAllister is demonstrated by Examiner Elahee's new and

improper construction of the Applicants claims after receiving Applicants response. After receiving Applicants' response, Elahee attempted to construe Applicants claims using a new and extrinsic source, instead of Applicants' own specification. While such a claim construction is improper, its inclusion in the final office action demonstrates that Applicants specifically distinguished McAllister. As will be shown below, Applicants' claims distinguish McAllister, are patentable, and should be allowed.

ARGUMENT

REJECTION UNDER 35 U.S.C § 102(e) OVER MCALLISTER

Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 stand rejected under 35 U.S.C 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242). To anticipate claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that McAllister must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that McAllister must enable Applicants' claims. McAllister does not meet either requirement and therefore does not anticipate Applicants' claims.

McAllister Does Not Disclose Each and Every Element of Applicants' Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). McAllister does not disclose each and every element of claim 1. Independent claim 1 claims "[a] method for externally identifying a particular caller, said method comprising: receiving a voice utterance for a caller at a server external to a trusted telephone network . . ." The Office Action of August 12, 2004, forms the rejection based upon improper construction of the phrase "trusted telephone network." The rejection is based upon one definition of the term "trusted" in Merriam-Webster's Collegiate Dictionary meaning "reliable" selected by Examiner Elahee without any

explanation as to the analysis performed to determine whether an extrinsic source is needed to define the claim term, without any explanation as to the analysis performed to select Merriam-Webster's Collegiate Dictionary as a source useful in defining the claim term, or without any explanation as to the analysis performed to select this particular definition. Reliance on extrinsic evidence without first evaluating Applicants' own specification is improper. Claims must be interpreted in light of the specification. *See Manual of Patent Examining Procedure* § 2111. The meaning of Applicants claims are clear and defined by the specification. Extrinsic evidence is not needed to define Applicants' claims.

With regard to McAllister, McAllister does not disclose "externally identifying a particular caller" including "receiving a voice utterance for a caller at a server external to a trusted telephone network" as defined in Applicants' specification and Applicants' claims. Instead, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. *See* McAllister, column 1, line 7; column 2, lines 29-30; and column 5, lines 32-67. McAllister does not even address trusted and untrusted telephone networks or externally identifying a particular caller as defined by Applicants' claims and specification. As such, independent claim 1 cannot be anticipated by McAllister and therefore should be allowed.

Claims 2-3, 5-7, and 9 depend from independent claim 1 and include all of the limitations of claim 1. Because McAllister does not disclose each and every element of claim 1, McAllister does not disclose each and every element of claims 2-3, 5-7, and 9. As such, claims 2-3, 5-7, and 9 are also patentable and should be allowed.

Independent claim 10 similarly claims "[a] system for externally identifying a particular caller" including "a server system communicatively connected to a trusted telephone network by an external network" and "and means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call." As

mentioned above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] system for externally identifying a particular caller” including “a server system communicatively connected to a trusted telephone network by an external network” and “and means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 10 is not anticipated by McAllister and therefore should be allowed.

Rejected dependent claims 11-12 and 14-16 depend from claim 10 and include all of the limitations of claim 10. Because McAllister does not teach each and every element of claim 10, McAllister also does not teach each and every element of claims 11-12, and 14-16. Claims 10-17 should be allowed.

Independent claim 18 recites “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Again, McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 18 is not anticipated by McAllister and therefore should be allowed.

Rejected dependent claims 19-21 depend from claim 18 and include all of the limitations of claim 18. Because McAllister does not teach each and every element of claim 18, McAllister also does not teach each and every element of claims 19-21. Claims 18-21 should be allowed.

Independent claim 52 recites “[a] method for controlling caller identification” including “receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] method for controlling caller identification” including “receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service” McAllister also does not address trusted and untrusted telephone networks or externally identifying a particular caller. As such, independent claim 52 is not anticipated by McAllister and should be allowed.

Independent claim 53 recites “[a] method for controlling a call” including “a secure communication channel via a trusted telephone network to an authentication service” As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “a secure communication channel via a trusted telephone network to an authentication service.” McAllister also does not address trusted and untrusted telephone

networks or a secure channel via trusted telephone network. As such, independent claim 53 is not anticipated by McAllister and should be allowed.

McAllister Does Not Enable
Applicants' Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53

Not only must McAllister disclose each and every element of claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also McAllister must be an enabling disclosure of Applicants' claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless McAllister places Applicants' claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 in the possession of a person of ordinary skill in the art, McAllister is legally insufficient to anticipate Applicants' claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 under 35 USC 102(e). Claims 1-3, 5-7, 9-12, 14-16, 18-20, 52, and 53 are therefore patentable and should be allowed.

McAllister does not enable claim 1. Independent claim 1 claims "a method for externally identifying a particular caller, said method comprising: receiving a voice utterance for a caller at a server external to a trusted telephone network . . ." McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose "externally identifying a particular caller" including "receiving a voice utterance for a caller at a server external to a trusted telephone network . . ." McAllister does not address trusted and untrusted telephone

networks or externally identifying a particular caller. McAllister therefore does not place one of ordinary skill in the art in possession of claim 1 and is therefore legally insufficient to anticipate claim 1.

Claims 2-3, 5-7, and 9 depend from independent claim 1 and include all of the limitations of claim 1. Because McAllister does not place one of ordinary skill in the art in possession of claim 1, McAllister does not place one of ordinary skill in the art in possession of claims 2-3, 5-7, and 9. As such, claims 2-3, 5-7, and 9 are also patentable and should be allowed.

McAllister does not enable independent claim 10. Independent claim 10 similarly claims “[a] system for externally identifying a particular caller” including “a server system communicatively connected to a trusted telephone network by an external network” and “and means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As mentioned above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] system for externally identifying a particular caller” including “a server system communicatively connected to a trusted telephone network by an external network” and “and means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. McAllister therefore does not place one of ordinary skill in the art in possession of claim 10 and is therefore legally insufficient to anticipate claim 10.

Claims 11-12 and 14-16 depend from claim 10 and include all of the limitations of claim 10. Because McAllister does not place one of ordinary skill in the art in possession of claim 10, McAllister also does not place one of ordinary skill in the art in possession of claims 11-12, and 14-16. As such, claims 10-12 and 14-16 should be allowed.

McAllister does not enable independent claim 18. Independent claim 18 recites “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] computer program product for externally identifying a particular caller” including “means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.” Again, McAllister does not address trusted and untrusted telephone networks or externally identifying a particular caller. McAllister therefore does not place one of ordinary skill in the art in possession of claim 18 and is therefore legally insufficient to anticipate claim 18. As such, claim 18 is therefore patentable and should be allowed.

Claims 19-21 depend from claim 18 and include all of the limitations of claim 18. Because McAllister does not place one of ordinary skill in the art in possession of claim 18, McAllister also does not place one of ordinary skill in the art in possession of claims 19-21. As such, claims 19-21 are not anticipated by McAllister and should be allowed.

McAllister does not enable independent claim 52. Independent claim 52 recites “[a] method for controlling caller identification” including “receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service . . .” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called

party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “[a] method for controlling caller identification” including “receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service”

McAllister also does not address trusted and untrusted telephone networks or externally identifying a particular caller. McAllister therefore does not place one of ordinary skill in the art in possession of claim 52 and is therefore legally insufficient to anticipate claim 52. As such, claim 18 is therefore patentable and should be allowed.

McAllister does not enable independent claim 53. Independent claim 53 recites “[a] method for controlling a call” including “a secure communication channel via a trusted telephone network to an authentication service” As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister does not disclose “a secure communication channel via a trusted telephone network to an authentication service.” McAllister also does not address trusted and untrusted telephone networks or a secure channel via trusted telephone network. McAllister therefore does not place one of ordinary skill in the art in possession of claim 53 and is therefore legally insufficient to anticipate claim 53. As such, claim 53 is therefore patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 4, 13, and 21 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister (U.S. Patent No. 6,442,242) in view of Bartholomew (U.S. Patent No. 6,167,119). Claims 8 and 17 stand newly rejected under 35 U.S.C § 103(a) as unpatentable over McAllister (U.S. Patent No. 6,442,242) in view of Yoon (U.S. Pub. No. 2001/0047414). Applicants respectfully traverse each rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

McAllister and Bartholomew

The Combination of McAllister and Bartholomew
Does Not Teach all Of Applicants' Claim Limitation

The combination of McAllister and Bartholomew does not teach or suggest all of Applicants' claim limitations. To establish a prima facie case of obviousness under 35 U.S.C. § 103 the proposed combination of McAllister and Bartholomew must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As described above, McAllister describes telephone auto

attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. Bartholomew describes a single network that provides communication services including intelligent peripherals and TCP/IP network connections. *See U.S. Patent No. 6,167,119, column 17, line 62 – column, 18, line 25; (“The illustrated IP also includes . . .”); column 9, lines 12-13 (“FIG. 1 provides a simplified illustrated of the preferred intelligent telephone network for implementing the personal dial tone service in accord with the present invention.”); column 11, line 63 – 66 (“The preferred telephone network includes one or more intelligent peripherals (IPs) 23. . . ”); and Figure 1.* Bartholomew does not cure the deficiencies of McAllister. Neither McAllister nor Bartholomew disclose or suggest “externally identifying a particular caller” or “trusted telephone networks” as claimed in claims 4, 13, and 21. As such, the combination of McAllister and Bartholomew cannot support a *prima facie* case of obviousness.

No Suggestion or Motivation to Combine McAllister and Bartholomew

There is no suggestion or motivation to combine McAllister and Bartholomew. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine McAllister and Bartholomew. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). As described above, neither McAllister nor Bartholomew address trusted and untrusted networks or externally identifying a particular caller. In fact, Bartholomew teaches away from “externally identifying a particular caller” by instead teaching a single preferred network. Therefore, the combination of McAllister and Bartholomew cannot support a *prima facie* case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of McAllister and Bartholomew

To establish a *prima facie* case of obviousness, there must also be a reasonable expectation of success in the proposed modification of McAllister. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination. Because McAllister or Bartholomew does not disclose externally identifying a particular caller or trusted telephone networks, their combination cannot work to disclose externally identifying a particular caller or trusted telephone networks. Said differently, McAlister and Bartholomew cannot together work to disclose what is not disclosed in either reference alone. The combination therefore fails to establish a *prima facie* case of obviousness.

McAllister and Yoon

No Suggestion or Motivation to Combine McAllister and Yoon

There is no suggestion or motivation to combine McAllister and Yoon. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine McAllister and Yoon. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The office action basis its rejection the phrase ‘IP’ in Yoon and equating the phrase ‘IP’ of Yoon with a server. ‘IP’ as described in Yoon stands for ‘Internet Protocol,’ which is a protocol. The Internet Protocol is not a server. As described above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. There is no teaching in either reference suggesting that the Internet Protocol is a server. Because the IP of Yoon is not a server, there is no suggestion or motivation to combine McAllister and Yoon as suggested in the office action. As such, the rejection should be withdrawn and the case should be allowed.

No Reasonable Expectation of Success in the
Proposed Combination of McAllister and Yoon

To establish a *prima facie* case of obviousness, there must also be a reasonable expectation of success in the proposed combination of McAllister and Yoon. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There is no reasonable expectation of success in the proposed combination. The office action basis its rejection the phrase ‘IP’ in Yoon and equating the phrase ‘IP’ of Yoon with a server. ‘IP’ as described in Yoon stands for ‘Internet Protocol,’ which is a protocol. The Internet Protocol is not a server. As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. Because the IP of Yoon is not a server, the suggested combination cannot work as described in the office action. The rejection should therefore be withdrawn and the case should be allowed.

The Combination of McAllister and Yoon
Does Not Teach all Of Applicants’ Claim Limitation

The combination of McAllister and Yoon does not teach or suggest all of Applicants’ claim limitations. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103 the proposed combination of McAllister and Yoon must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The office action basis its rejection the phrase ‘IP’ in Yoon and equating the phrase ‘IP’ of Yoon with a server. ‘IP’ as described in Yoon stands for ‘Internet Protocol,’ which is a protocol. The Internet Protocol is not a server. As described above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called

party to a PBX to complete the call. Because the IP of Yoon is not a server, the suggested combination as described in the office action itself does not disclose each and every element of Applicant's claims. As such, the rejection should be withdrawn and the case should be allowed.

The Four Factual Inquiries Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, and Applied

Establishing a *prima facie* case of obviousness for claims 4, 8, 13, 17 and 21, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be

uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over two years of prosecution the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and all four factual inquiries have not been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each office action the Examiner has only identified elements in Applicants' claims not found in McAllister and then attempted to find a similar element in another reference to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not

whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The office actions of April 23, 2003, October 8, 2003, and August 12, 2004 are deficient because the Examiner has only identified differences between Applicants claims, McAllister, Bartholomew, and Yoon. This analysis is improper and incomplete because Examiner has not determined whether Applicants claims as a whole would have been obvious in view of a combination of McAllister and Bartholomew or Yoon as required by the Manual of Patent Examining Procedure. In fact, the Examiner has not even mentioned how any claim as a whole would be obvious in rejecting any claim. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The office actions of April 23, 2003, October 8, 2003, and August 12, 2004 fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over two years of prosecution and three office actions, no analysis at all considering the level of one of ordinary skill in

the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

CONCLUSION

McAllister does not teach each and every element of claims 1-21, 52, and 53. McAllister therefore does not anticipate claims 1-21, 52, and 53. The proposed combinations of McAllister and Bartholomew and McAllister and Yoon also fail to establish a prima facie case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations. Applicants respectfully request the allowance of claims 1-21, 52, and 53.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: December 7, 2004

By:

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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/015,281

CLAIMS

What is claimed is:

1. A method for externally identifying a particular caller, said method comprising:
 - receiving a voice utterance for a caller at a server external to a trusted telephone network; and
 - identifying a caller identity associated with said voice utterance at said server, such that said caller identity is transmittable within said trusted telephone network as an authenticated identity of said caller for a call.
2. The method for externally identifying a particular caller according to claim 1, wherein receiving a voice utterance further comprises:
 - receiving said voice utterance through a secure channel between said server and said trusted telephone network.
3. The method for externally identifying a particular caller according to claim 1, further comprising:

receiving, at said server, a request for a caller identity authentication service from said trusted telephone network; and

prompting said caller to provide said voice utterance.

4. The method for externally identifying a particular caller according to claim 1, wherein identifying a caller identity further comprises:

extracting speech characteristics from said voice utterance; and

comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

5. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises at least one public switching telephone network.

6. The method for externally identifying a particular caller according to claim 1, wherein said trusted telephone network comprises a private switching system.

7. The method for externally identifying a particular caller according to claim 1, further comprising:

accessing said server from said trusted telephone network through an Internet connection.

8. The method for externally identifying a particular caller according to claim 1, further comprising:

accessing said server from said trusted telephone network through a private network connection.

9. The method for externally identifying a particular caller according to claim 1, further comprising:
 - transferring said caller identity to said trusted telephone network through a secure channel.
10. A system for externally identifying a particular caller, said system comprising:
 - a server system communicatively connected to a trusted telephone network by an external network;
 - means for receiving a voice utterance for a caller at said server system;
 - means for identifying a caller identity associated with said voice utterance;
 - means for transmitting said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.
11. The system for externally identifying a particular caller according to claim 10, wherein said means for receiving a voice utterance further comprises:
 - means for receiving said voice utterance through a secure channel between said server system and said trusted telephone network.
12. The system for externally identifying a particular caller according to claim 10, further comprising:
 - means for receiving, at said server system, a request for a caller identity authentication service from said trusted telephone network; and
 - means for prompting said caller to provide said voice utterance.

13. The system for externally identifying a particular caller according to claim 10, wherein said means for identifying a caller identity further comprises:

means for extracting speech characteristics from said voice utterance; and means for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

14. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises at least one public switching telephone network.

15. The system for externally identifying a particular caller according to claim 10, wherein said trusted telephone network comprises a private switching system.

16. The system for externally identifying a particular caller according to claim 10, wherein said external network is the Internet.

17. The system for externally identifying a particular caller according to claim 10, wherein said external network is a private network.

18. A computer program product for externally identifying a particular caller, said computer program product comprising:

a recording medium;

means, recorded on said recording medium, for enabling receipt of a voice utterance for a caller at a server system communicatively connected to a trusted telephone network via an external network;

means, recorded on said recording medium, for identifying a caller identity associated with said voice utterance;

means, recorded on said recording medium, for controlling transmission of said caller identity to said trusted telephone network as an authenticated identity of said caller for a call.

19. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, said voice utterance through a secure channel between said server system and said trusted telephone network.

20. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for enabling receipt at said server system of a request for a caller identity authentication service from said trusted telephone network; and

means, recorded on said recording medium, for prompting said caller to provide said voice utterance.

21. The computer program product for externally identifying a particular caller according to claim 18, further comprising:

means, recorded on said recording medium, for extracting speech characteristics from said voice utterance; and

means, recorded on said recording medium, for comparing said speech characteristics with a plurality of voice samples stored for identifying a plurality of callers.

52. A method for controlling caller identification, comprising:

receiving, from a trusted telephone network, an authenticated caller identity for a caller at a telephony device, wherein said caller identity is authenticated at a authentication service accessible via a network external to said trusted telephone network, wherein said trusted telephone network initiates said authentication service; and

controlling output of said authenticated caller identity from said telephony device, such that an individual with access to said telephony device is informed of the identity of said caller.

53. A method for controlling a call, comprising:

receiving, at a telephony device, a secure communication channel via a trusted telephone network to an authentication service, wherein said trusted telephone network initiates said authentication service; and

facilitating, from said telephony device, communications between said authentication service and a caller, such that said authentication service is enabled to authenticate an identity of said caller.